

U.S. Application Serial No. 09/671,941

### **R E M A R K S**

The present response is responsive to the Official Action dated October 10, 2003, made final, and is being filed after the filing of a Notice of Appeal, but prior to the submission of an appeal brief. In the Official Action, pending claims 1-19 were rejected. More specifically, the Examiner continues to reject claims 1-19 as being anticipated by Matsushima et al., US Patent Application Publication No. 2002/0161722. However the Examiner has failed to cure the defect of the reference, which was previously identified by the applicant, where the Examiner has failed to establish that the cited reference qualifies as prior art, and consequently that the reference was appropriately cited against the present application. Consequently, the Examiner has failed to present a prima facie case of anticipation, which would necessitate a response by the applicant. In other words, the Examiner's rejection continues to be improperly supported and/or defective, and has never been properly established, such that a response by the applicant would be required.

More specifically, based upon the facts in the record, Matsushima et al., '722, can not be established as a prior reference given the filing date of the corresponding PCT application is January 12, 2001, which is after the filing date September 27, 2000, of the present application. While, as noted previously, the reference identifies a related application, which was filed January 14, 2000, the related application is identified as a continuation-in-part application with no basis upon fact properly established in the record as to what portions of the presently cited reference may have been originally present or may have been later added.

By definition, a continuation-in-part application implies that additional subject matter has been added to the application from which the continuation-in-part application claims priority (see MPEP §201.08). Still further, unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, the MPEP indicates that there is no need to make a determination as to whether the earlier nonprovisional application discloses the invention of the second application. In fact, the Examiners are encouraged to merely insure that the minimal formalities of 35 U.S.C. §120 are met. Still further, the status of the present application is further in doubt given the fact that there is no indication that the cited reference has undergone any form of substantive examination, and therefore there may not have been any opportunity to evaluate the proper priority of the published

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application, even under the above outlined very limited set of circumstances, in which such an analysis might be required.

In responding to the Applicants' earlier criticism relative to the presently cited reference, the Examiner indicates that he has only minimally reviewed the earlier application. Ironically, to the extent that the Examiner attempts to show that the earlier application is directed to a similar scope, the Examiner identifies elements in the earlier application, which have completely different reference numbers that fail to match any of the element/reference numbers in the later application. This would alternatively suggest that the references are more different than similar, making it seemingly less likely that the later application is entitled to the earlier filing date. Consequently, based upon the Examiner's own admissions relative to the description of the applications provided, the Examiner's showing serves to alternatively suggest that the applications contain substantial differences, and most notably in the specific areas of concern, and more importantly failed to establish the presence of the relied upon subject matter as being present in the earlier application.

Still further, in attempting to justify the appropriateness of the use of the earlier priority date in association with the cited reference, the Examiner fails to provide the complete analysis, which is required to establish the suitability of an association of the earlier priority date. More specifically, in order for a continuation-in-part application to be entitled to the filing date associated with the parent application, not only must the Examiner show that the teachings being relied upon in support of the rejection are present in the earlier application, but the Examiner must also show that the later filed claims are supported by the earlier specification (please see MPEP §2136.03 IV). No such showing by the Examiner has been made or attempted. Consequently, the Examiner has failed to support a showing that the cited reference is entitled to the priority date of the parent application, and as a result has failed to articulate a rejection, which meets the requirements of a prima facie showing of anticipation.

The Examiner bears the burden of presenting at least a prima facie case of anticipation, and it is only when that burden is met, that there is an obligation for the applicant to respond. In re Sun, 31 USPQ2d 1451, 1456 (Fed Cir. 1993). In the present instance no prima facie case of anticipation has been established, and consequently the applicant does not have an obligation, up to this point, to even respond.

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To the extent that the Examiner has attempted to allege that the cited reference is entitled to claim priority to the filing date of the parent application, as noted above, the Examiner has relied solely upon alleged facts, which have not been made part of the record. More specifically, the Examiner has relied upon alleged teachings of the parent application, without providing a copy of the parent application to the applicant or including the same as part of the record. To the extent that the Examiner attempts to rely upon facts, which are not part of and/or are supported in the record, the rejection can only be said to be supported by some form of Official Notice. However Official Notice can only be used to assert well known facts, which are capable of such instant and unquestionable demonstrations as to defy dispute. Such is not the case in the present instance. Furthermore, when the appropriateness of the alleged facts are called into question, as they were in the applicants' prior response, the Examiner is then obligated to provide support and or a basis for the alleged fact. Here the Examiner has failed to comply with this obligation by failing to produce a copy of the reference from which the Examiner claims support.

In absence of a properly supported rejection, the rejection should be withdrawn, and the application allowed to proceed to issuance. Still further, until a proper rejection is established, and the applicants are given a full and fair opportunity to evaluate the merits of the rejection, and correspondingly an opportunity to respond, and in absence of an allowance, the finality of the rejection should minimally be withdrawn. The applicants would respectfully request the reconsideration and reexamination of the present application in view of the present response and remarks. In the event, that there are any remaining unresolved issues precluding the issuance of the present application after consideration of the present response, before issuing a further rejection, the Examiner is respectfully requested to contact the applicants' agent at the below listed number to discuss the same.

Respectfully submitted,

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